

REMARKS

Claim Rejections – 35 U.S.C. § 101

Claims 10-28 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action at page 2, states:

Claims 10-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims do not restrict the claimed invention to statutory classes of invention. Rather, the specification defines computer program products embodied on a recording medium to encompass transmission media. (See Specification, pg. 6, line 22) Hence, these claims are limited to statutory subject matter.

That is, the Office Action takes the position that Applicants' usage of the term 'recording medium' in claims 19-28 renders Applicants' claims outside realm of statutory subject matter because 'recording medium' encompasses 'transmission medium.' As confirmed in the telephone conversation with Examiner Kim on December 12, 2007, claims 10-18 are rejected as non-statutory subject matter because the 'means' in the 'means for' limitations of claims 10-18 may include the 'recording medium' of claims 19-28. For the reasons discussed below, Applicants' claims 19-28 that include 'recording medium' are statutory subject matter entitled to patent protection. As such, Applicants' claims 10-18 are also within the realm of statutory subject matter, and the rejection of Applicants' claim 10-28 under 35 U.S.C. § 101 should be withdrawn.

In asserting that Applicants' claims are directed toward non-statutory subject matter because 'recording medium' encompasses 'transmission medium,' the Office Action implies that Applicants' claims are directed toward non-statutory subject matter because a 'transmission medium' may be used to transfer signals. The current law regarding the patentability of signals is *In re Nuijten*, No. 06-1371 (Fed. Cir. 2007). In *Nuijten*, the Court held that a signal claimed as signal is not statutory subject matter eligible for patentability. Applicants note in the present application, however, that Applicants are not claiming a signal as a signal—rather, Applicants are claiming a computer program

product that includes a recording medium on which suitable programming means may be recorded. In fact, the Court in *Nuijten* noted that the Board of Patent Appeals and Interferences (‘BPAI’) decided that a similar claiming pattern in *Nuijten* was directed toward statutory subject matter stating:

Finally, Nuijten’s allowed Claim 15 is directed to “[a] storage medium having stored thereon a signal with embedded supplemental data...”

...

On appeal, the Board reversed the double-patenting rejections. As to Claim 15, it found that “[t]he storage medium in claim 15 nominally puts the claim into the statutory category of a ‘manufacture’” and thus reversed the Examiner’s § 101 rejection of that claim.

For the same reasons that the BPAI held that the claims in *Nuijten* directed toward storage medium having stored thereon a signal with embedded supplemental data, Applicants submit that claims 19-28 directed toward a computer program product that includes a recording medium on which suitable programming means may be recorded is also patentable under 35 U.S.C. § 101. As such, Applicants’ claims 10-18 are also directed toward statutory subject matter.

Furthermore, Applicants noted that even though the term ‘recording medium’ encompasses the term ‘transmission medium,’ Applicants’ original specification describes a ‘transmission medium’ as being a suitable recording medium for machine-readable information, which is used to embody the computer program product claimed in the present application. Nothing in the cited reference or any other language in the specification or the claims describes ‘transmission media’ as a signal or under any reasonable interpretation implies that Applicants are claiming a signal. In addition, Applicants note that the Fifth Edition of the Microsoft Computer Dictionary defines the term ‘media’ as “a physical material, such as paper, disk, and tape, used for storing computer-based information.” One of ordinary skill in the art would therefore understand that ‘transmission media’ is a physical material and entitled to patent protection under 35 U.S.C. § 101 as an article of manufacture or a composition of matter. The rejections of

claims 10-28 under 35 U.S.C. § 101 are improper, and should therefore be withdrawn. Applicants respectfully request reconsideration of claim 10-28.

Claim Rejections – 35 U.S.C. § 102

Claims 1-6, 10-15, 19-24, and 27 stand rejected under 35 U.S.C. § 102 as being anticipated by Botz, *et al.* (U.S. Patent No. 6,981,043) (hereafter, ‘Betz’). To anticipate claims 1-6, 10-15, 19-24, and 27 under 35 U.S.C. § 102, Betz must disclose each and every element and limitation recited in the claims of the present application. As explained below, Betz does not disclose each and every element and limitation recited in the claims of the present application and therefore does not anticipate the claims of the present application.

Betz Does Not Disclose Each And Every Element Of The Claims Of The Present Application

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Independent claim 1 recites:

1. A method for cross domain security information conversion, the method comprising:

receiving from a system entity, in a security service, security information in a native format of a first security domain regarding a system entity having an identity in at least one security domain;

translating the security information to a canonical format for security information;

transforming the security information in the canonical format using a predefined mapping from the first security domain to a second security domain;

translating the transformed security information in the canonical format to a native format of the second security domain; and

returning to the system entity the security information in the native format of the second security domain.

**Botz Does Not Disclose Receiving From A System Entity, In A Security Service,
Security Information In A Native Format Of A First Security Domain And
Returning To The System Entity The Security Information In
The Native Format Of The Second Security Domain**

The Office Action takes the position that Botz at column 14, lines 17-34, discloses the first element and the fifth element of claim 1: receiving from a system entity, in a security service, security information in a native format of a first security domain regarding a system entity having an identity in at least one security domain and returning to the system entity the security information in the native format of the second security domain. Applicants respectfully note in response, however, that what Botz at column 14, lines 17-34, in fact discloses is:

The identity mapping mechanism of the present invention provides an infrastructure for creating mappings between local user identities in different user registries on a network. In the preferred embodiment, a global identifier is created for each user, and each local user identity that corresponds to the global identifier is mapped to the global identifier. Once the relationship between the local user identities and the global identities is established, the infrastructure can then be used to determine from one local user identity a corresponding local user identity in a different user registry. The identity mapping mechanism thus allows user information in one environment to automatically retrieve user information in a different environment, thereby avoiding the necessity of the user remembering multiple usernames and passwords. Once a user is authorized

to the network, and requests access to a resource, the security semantics for obtaining access to the resource may be satisfied by invoking the appropriate EIM APIs and submitting the appropriate security information.

That is, Botz, at column 14, lines 17-34, discloses a user identity mapping mechanism for mappings together a user's local identities stored in different user registries. Botz's user identity mapping mechanism, however, does not disclose receiving from a system entity, in a security service, security information in a native format of a first security domain regarding a system entity having an identity in at least one security domain and returning to the system entity the security information in the native format of the second security domain as claimed in the present application because Botz's user identity mapping mechanism operates exclusively within a *single* domain to correlate a user's local user identities stored in different user registries within the *single* domain. Botz at column 9, line 59, states that a domain "represents a logical division for managing user identities." Botz then goes on to describe how a global identifier for a user is used to map a user's local identity in a user registry within a domain to that user's local identity in a different user registry within the *same* domain. See Botz at column 9, line 59, through column 10, line 25, and Figure 14. That is, Botz never receives security information in a native format of a first security domain and returns the security information in the native format of a second security domain as claimed in the present application because Botz is only concerned with mapping user identities among registries within a *single* domain. Because Botz does not disclose each and every element and limitation of Applicants' claims, Botz does not anticipate Applicants' claims, and the rejections under 35 U.S.C. § 102 should be withdrawn.

Botz Does Not Enable Each and Every Element Of The Claims Of The Present Application

Not only must Botz disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Botz must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims

were rejected because an earlier patent disclosed a structural similarity to the Applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Botz places Applicants' claims in the possession of a person of ordinary skill in the art, Botz is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102. As explained above, Botz does not disclose each and every element and limitation of independent claim 1 of the present application. Because Botz does not disclose each and every element, Botz cannot possibly place the elements and limitations of the independent claims in the possession of a person of ordinary skill in the art. Botz cannot, therefore, anticipate claim 1 of the present application.

Relations Among Claims

Independent claims 10 and 19 are system and computer program product claims for cross domain security information conversion corresponding to independent method claim 1. As explained above in detail, Botz does not disclose or enable a method for cross domain security information conversion. Therefore, for the same reasons that Botz does not disclose or enable a method for cross domain security information conversion, Botz also does not disclose or enable a system or a computer program product for cross domain security information conversion corresponding to independent claims 10 and 19. Independent claims 10 and 19 are therefore patentable and should be allowed.

Claims 2-6, 11-15, 20-24, and 27 depend from independent claims 1, 10, and 19. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Botz does not disclose or enable each and every element of the independent claims, Botz does not disclose or enable each and every element of the

dependent claims of the present application. As such, claims 2-6, 11-15, 20-24, and 27 are also patentable and should be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 7-9, 16-18, 25-26, and 28 stand rejected for obviousness under 35 U.S.C. § 103 as being unpatentable over Botz in view of Bussler, *et al.* (U.S. Patent No. 7,072,898). The question of whether Applicants claims are obvious or not is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a prima facie case of obviousness to reject Applicants claims under for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of the claim limitations of dependent claims 7-9, 16-18, 25-26, and 28. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Dependent claims 7-9, 16-18, 25-26, and 28 depend from independent claims 1, 10, and 19 and include all the limitations of the independent claims from which they depend. In rejecting dependent claims 7-9, 16-18, 25-26, and 28, the Office Action relies on Botz as disclosing each and every element of independent claims 1, 10, and 19. As shown above, Botz in fact does not disclose each and every element of independent claims 1, 10, and 19. Moreover, Bussler does not cure the deficiencies of Botz in disclosing each and every element and limitation of independent claims 1, 10, and 19. Because Botz does not disclose each and every element of independent claims 1, 10, and 19 and because Bussler does not cure the deficiencies of Botz, the combination of Botz and Bussler cannot possibly disclose each and every element of dependent claims 7-9, 16-18, 25-26, and 28. The proposed combination of Botz and Bussler, therefore, cannot be used to establish a prima facie case of obviousness, and the rejections 35 U.S.C. § 103(a) should be withdrawn.

In addition to Botz and Bussler not disclosing each and every limitation of the independent claims, the combination of Botz and Bussler also does not disclose the other limitations of Applicants dependent claims. Specifically, Applicants note that the combination of Botz and Bussler does not disclose the following limitations: mapping a system entity's identity in the first security domain to a another identity in the second security domain; receiving a request for security information for the second security domain, wherein the request encapsulates the security information in a native format of a first security domain; translating the security information in a native format of a first security domain to a canonical format is carried out through a procedural software function; the native format of the first security domain is expressed in XML, the canonical format is expressed in XML, and translating the security information in a native format of a first security domain to a canonical format is carried out in dependence upon a mapping, expressed in XSL, from the native format of the first security domain to a canonical format; the canonical format is expressed in XML and the predefined mapping from the first security domain to a second security domain is expressed in XSL; and the second native format is expressed in XML, the canonical format is expressed in XML, and translating the transformed security information in the canonical format to a native format of the second security domain is carried out in dependence upon a predefined mapping, expressed in XSL, from the canonical format to the native format of the second security domain.

Conclusion

The Office Action rejects claims 10-28 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. As explained above, Applicants' claims 10-28 are directed toward statutory subject matter entitled to patent protection under 35 U.S.C. § 101. Applicants therefore respectfully traverse the rejection and request reconsideration of claims 10-28.

Claims 1-6, 10-15, 19-24, and 27 stand rejected under 35 U.S.C. § 102 as being anticipated by Botz. Botz does not disclose each and every element of Applicants' claims and does not enable Applicants' claims. Botz therefore does not anticipate Applicants' claims. Claims 1-6, 10-15, 19-24, and 27 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-6, 10-15, 19-24, and 27.

Claims 7-9, 16-18, 25-26, and 28 stand rejected under 35 U.S.C. § 103 as obvious over Botz in view of Bussler. The combination of Botz and Bussler does not teach or suggest each and every element of Applicants' claims. Claims 7-9, 16-18, 25-26, and 28 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 7-9, 16-18, 25-26, and 28.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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